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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,371	03/09/2004	Adam J. Katz	30448.77USD1	4480

7590 05/23/2008  
MANDEL & ADRIANO  
SUITE 203  
572 EAST GREEN STREET  
PASADENA, CA 91101

EXAMINER
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QIAN, CELINE X

ART UNIT	PAPER NUMBER
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1636

MAIL DATE	DELIVERY MODE
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05/23/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/797,371

**Applicant(s)**

KATZ ET AL.

**Examiner**

CELINE X. QIAN

**Art Unit**

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 39-42, 44, 45, 47, 48, 57, 160-162 and 169-182 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-42, 44, 45, 47, 48, 57, 160-162 and 169-182 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/30/07, 12/27/07
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 39-42, 44, 45, 47, 160-162 and 169-182 are pending in the application.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/27/07 has been entered.

#### ***Response to Amendment***

The information disclosure statement (IDS) submitted on 11/30/07 and 12/27/07 have been considered by the examiner.

All rejection presented in the previous office action mailed on 2/26/07 is maintained for same reason as set forth of the record because Applicants have not provided any arguments or amended the claims that would overcome the rejection. The office action mailed on 2/26/07 is presented below.

#### ***Response to Arguments***

##### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 39-42, 44, 45, 47, 48, 57, 160-162 and 169-182 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for reasons of record as set forth in the office action mailed on May 5, 2006. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This rejection is maintained and applied to the new claims as amended.**

Applicant's argue that the current amendment to the claims render the rejection moot.

In response to applicant's arguments, the addition of the limitation of "clonally" to the isolated adipose-derived stem cell does render the rejection for written description moot. A structural and functional relationship for all of the characteristics of a clonally isolated adipose derived stem cell that allow it to function as a stem cell that can develop into any mesodermal tissue is still not provided.

Claims 39-42, 44, 45, 47, 48, 57, 160-162 and 169-182 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for reasons of record as set forth in the office action mailed on May 5, 2006 and above.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 39-42, 44, 45, 47, 48, 57, 160-162 and 169-182 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and

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distinctly claim the subject matter which applicant regards as the invention for reasons of record as set forth in the office action mailed on May 5, 2006. **This rejection is repeated below and applied to the new claims added in the amendment.**

The metes and bounds of the claimed subject matter are not defined. The word "derived" is unclear since it does not define the scope of the limitations. Without a clear statement of the process by which the starting material is derivatized it is not possible to know the metes and bounds of such a limitation because any given starting material can have many divergent derivatives depending on the process of derivatization.

The applicant has not responded to this rejection. Therefore, this rejection is maintained.

Claims 39-42, 44, 45, 47, 48, 57 and 160-162 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 102

The rejection of claims 39, 40, 41, 45, 57 and 160 under 35 U.S.C. 102(e) as being anticipated by Halvorsen et al (US 2002/0119126; made of record in the office action mailed August 9, 2005) is withdrawn.

Claim Rejections - 35 USC § 103

The rejection of claim 161 under 35 U.S.C. 103(a) as being unpatentable over Halvorsen et al (US 2002/0119126; made of record in the office action mailed August 9,

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2005) in view of Golde et al (US 4,438,032; made of record in the office action mailed August 9, 2005) is withdrawn.

The rejection of claim 162 under 35 U.S.C. 103(a) as being unpatentable over Halvorsen et al (US 2002/0119126; made of record in the office action mailed August 9, 2005) in view of Gimble et al (US 6,555,374; made of record in the office action mailed August 9, 2005) is withdrawn.

#### Double Patenting

The provisional rejection of claims 39-42, 44, 45, 67, 48 and 160 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 58-60, 67, 76-78, 80, 81, 83 and 84 of copending Application No. 10/845,315 is withdrawn.

#### ***New Grounds of Rejection***

These new rejection were necessitated by applicant's amendment.

#### ***Claim Objections***

Claim 40 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim limits the invention to any of an adipogenic, osteogenic, chondrogenic and myogenic medium, which are already claimed in independent claim 39.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 40 and 178 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 40, the metes and bounds of the claimed invention are unclear. How will further limiting the invention to using a medium that is dermatogenic, embryonic, fetal or stromogenic result in differentiating the stem cell into a in a fat, bone, cartilage or muscle cell?

Regarding claim 178, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CELINE X. QIAN whose telephone number is (571)272-0777. The examiner can normally be reached on 10-6:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe Woitach Ph.D. can be reached on 571-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Celine X Qian Ph.D./  
Primary Examiner, Art Unit 1636